D-1077+1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Previous Appeal No.: **2003-1651**)	
)	
In re Application of:)	
Jay Paul Drummond, et al.)	Art Unit 3621
)	
Serial No.: **09/193,787**)	
)	
Confirmation No.: **2446**)	Patent Examiner
)	Jalatee Worjloh
Filed: **November 17, 1998**)	
)	
Title: **Automated Banking Machine**)	
Apparatus and System)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL APPEAL BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 41.37

Sir:

The Appellants hereby respectfully request reinstatement of the appeal. The Appellants

hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the

above-referenced Application. This Supplemental Appeal Brief is in response to the Office

Action dated May 9, 2006.

(i)   **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is

Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

In this application a Board decision regarding Appeal No. 2003-1651 was previously rendered on October 8, 2003. In said decision the Examiner was reversed on all issues. A copy of the decision can be found in the Related Proceedings Appendix.

Other applications (e.g., 09/193,791; 09/193,564; 09/193,662) having been assigned appeal numbers claim priority to the parent application (09/077,337), which was also appealed. It is believed that these other appeals do not pertain to the subject matter claimed herein. However, it is respectfully requested that the Board make its own determination regarding the pertinence of these other applications. The Board is also requested to check the appeal status of other applications claiming priority to the parent application.

Appellants, Appellants' legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)   **STATUS OF CLAIMS**

Claims 1-30 are pending in the Application.

Claims rejected:	1-30
Claims allowed:	none
Claims confirmed:	none
Claims withdrawn:	none
Claims objected to:	none
Claims canceled:	none

Appellants appeal the rejections of claims 1-30, inclusive. These rejections were the only rejections present in the Office Action ("Action") dated May 9, 2006.

(iv)   **STATUS OF AMENDMENTS**

No final rejection is pending. However, claims have been rejected at least seven times. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

The following dates and papers are associated with this application:

1.	11/05/01	First Non-final Office Action Rejection
2.	04/16/02	Second Non-final Office Action Rejection
3.	04/23/02	Notice of Appeal
4.	06/24/02	1st Appeal Brief
5.	09/16/02	Third Non-final Office Action Rejection
6.	01/17/03	2nd Appeal Brief
7.	03/11/03	Examiner's Answer
8.	04/18/03	Reply Brief
9.	10/08/03	Decision on Appeal -- Examiner Reversed
10.	07/28/04	Fourth Non-final Office Action Rejection
11.	10/21/04	Notice of Appeal
12.	12/17/04	3rd Appeal Brief
13.	10/18/05	Fifth Non-final Office Action Rejection
14.	02/16/06	Sixth Non-final Office Action Rejection
15.	05/09/06	Seventh Non-final Office Action Rejection
16.	08/09/06	Notice of Appeal
17.	current	4th Appeal Brief

This application was filed on November 17, 1998. Appellants' *original* independent claims still have not been amended. Yet this application has received continued reopening of prosecution, including seven non-final rejections. As factually evidenced by the prosecution history, the Office's propensity to continuously prosecute this application is not in conformance with the Office's normal and expected examining procedures, especially with regard to "compact prosecution." In light of the assigned Group's inability to efficiently examine this application, this application should be transferred to an examining Group that is capable of meeting the stated prosecution goals of the Office. The obfuscation and delay by the examining Group, as evidenced by the record, shows a pattern of arbitrary and capricious action and evidence of willful or wanton misconduct against Appellants.

The repeated imposition of new grounds of rejection by the Office in an effort to deny Appellants judicial review of the refusal to grant their application constitutes an abuse of agency authority. Such actions violate the Administrative Procedures Act, 5 U.S.C. § 701 *et seq.* Such agency action also violates the fundamental legal principle that an administrative agency may not avoid review of its actions by engaging in repetitive activity which does not remain in place long enough to enable judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S. Cr. 279 (1911).

In light of the Office's propensity to continually reopen prosecution (instead of writing an Examiner's Answer), Appellants reserve all rights and effort to add additional arguments in a Reply Brief (after an Examiner's Answer is actually written). Regardless, as shown in more detail herein, Appellants' claims are allowable over the Office's latest (seventh) grounds of rejection. Thus, Appellants yet again respectfully request reinstatement of their appeal.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

For reasons of brevity, claim language may be referred to herein (and in Appellants' arguments) in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

<u>With respect to independent claim 1</u>

An exemplary form of the invention is directed to an apparatus. The apparatus comprises an automated banking machine (12) (page 11, lines 13-14; page 13, lines 4-5). The exemplary embodiment of the automated banking machine is an automated teller machine ("ATM").

The automated banking machine (12) includes an output device (e.g., display screen 30) (page 7, line 2; page 13, lines 5-6). The output device can output information, enabling an automated banking machine user to perceive outputs from the output device.

The automated banking machine (12) includes an input device (e.g., keyboard 40 or reader device 38) (page 7, line 3; page 9, lines 4-5; page 13, lines 12-13; and page 29, lines 20-21). The input device can receive inputs, enabling a user of the automated banking machine to provide inputs to the machine.

The automated banking machine (12) includes a transaction function device (36; 42) (page 13, lines 11-18). The transaction function device (36; 42) can selectively carry out a transaction function.

The automated banking machine (12) includes a computer (34). The computer (34) is in operative connection with the output device, the input device, and the transaction function device (page 13, lines 8-12).

The automated banking machine (12) includes software (e.g., 64, 76, 80) executable in the computer (34) (page 14, lines 11-13; page 15, lines 17-18; page 16, lines 9-18). The software includes a browser (76) (page 15, lines 17-18). The browser (76) can process HTML documents having instructions therein (page 16, lines 9-15; page 53, lines 8-9). The transaction function device (36; 42) can carry out (page 20, lines 7-8) the transaction function responsive to the browser (76) processing at least one document including at least one instruction that can cause the computer (34) to cause operation of the transaction function device (36; 42) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

Thus, in an exemplary form of the invention, an ATM (12) can receive HTML documents containing operation instructions, process the instructions using the ATM browser (76), and then (in response to the instructions) cause the ATM computer (34) to operate an ATM transaction function device to carry out an ATM banking transaction function. The HTML document instructions cause the ATM computer (34) to operate the ATM transaction function device.

An example of operation of an exemplary embodiment encompassed by claim 1 will now be described. The ATM is connected to a network such as the Internet and receives at least one HTML document from a remote server computer connected in the network. The received HTML document includes embedded JAVA® script or other instructions that are processed by the ATM browser. The ATM computer includes software comprising a JAVA applet associated with the operation of a currency note dispenser in the ATM. The ATM computer processed instructions

operate in the JAVA environment to communicate a message to the JAVA applet associated with the currency note dispenser. Thus, the ATM computer operates in response to instructions included in the received HTML document to control a currency note dispenser to dispense currency notes.

With respect to independent claim 8

Another exemplary form of the invention is directed to the Automated Teller Machine (ATM) (12) of claim 8 (page 11, lines 13-14; page 13, lines 4-5). The ATM (12) includes a computer (34) (page 13, lines 8-12) with a browser (76) (page 15, lines 17-18). The ATM (12) also includes a transaction function device (36; 42) (page 13, lines 11-18) in operative connection with the computer (34). The transaction function device can carry out a transaction function responsive to at least one HTML format document that is received by the browser (76) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20; page 16, lines 9-15; page 53, lines 8-9; page 60, lines 5-8). Particularly note Figures 2 and 11.

With respect to independent claim 9

Another exemplary form of the invention is directed to the method of claim 9. The method comprises operating a browser (76) in at least one computer (34) in connection with an automated banking machine (12). The method further comprises receiving at least one HTML format document with the browser (76) (page 16, lines 9-15). The at least one HTML format document includes at least one transaction instruction (page 9, lines 17-20; page 53, lines 8-9; page 60, lines 5-8). The method also comprises carrying out (page 20, lines 7-8) at least one transaction function with a transaction function device (36; 42) in the automated banking

machine (12) responsive to the at least one HTML format document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20).

The previous discussions of automated banking machine (12), computer (34), and browser (76) are herein incorporated by reference. Particularly note Figures 2 and 11.

With respect to independent claim 11

Another exemplary form of the invention is directed to the method of claim 11. The method comprises operating a browser (76) in at least one computer (34) in operative connection with an automated banking machine (12). The method further comprises receiving at least one document with the browser (76) (page 16, lines 9-15). The document includes at least one transaction instruction embedded therein (page 9, lines 17-20; page 53, lines 8-9; page 60, lines 5-8). For example, note "embedded" at page 12, line 3; page 16, lines 11 and 13; page 33, line 12; page 39, line 2; and page 45, line 12. The method also comprises carrying out (page 20, lines 7-8) at least one transaction function with a transaction function device (36; 42) in the automated banking machine (12) responsive to the at least one document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20).

The previous discussions of automated banking machine (12), transaction function device (36; 42), computer (34), and browser (76) are herein incorporated by reference. Particularly note Figures 2 and 11.

With respect to independent claim 12

Another exemplary form of the invention is directed to the Automated Teller Machine (ATM) (12) of claim 12 (page 11, lines 13-14; page 13, lines 4-5). The ATM (12) can operate (36; 42) to conduct (page 20, lines 7-8) at least one financial transaction responsive to at least

one mark-up language document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

With respect to independent claim 13

Another exemplary form of the invention is directed to the automated banking machine (12) of claim 13. The automated banking machine (12) comprises a computer (34) and at least one transaction function device (36; 42) in the banking machine (12). The at least one transaction function device (36; 42) is adapted to carry out at least a portion of a banking transaction (page 33, lines 11-13). The computer is adapted to cause at least one banking transaction to be carried out through operation of the at least one transaction function device responsive to at least one mark up language document (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

With respect to independent claim 16

Another exemplary form of the invention is directed to the method of claim 16. The method comprises providing an automated banking machine (12) including at least one transaction function device (36; 42). The automated banking machine is in operative connection with at least one computer (34). The method further comprises processing (page 16, lines 9-15; page 53, lines 8-9) at least one mark up language document with the computer (34, 76) (page 15, lines 17-18). The method also comprises carrying out (page 20, lines 7-8) at least a portion of a banking transaction with the transaction function device (36; 42) responsive to processing the at least one mark up language document with the computer (34) (page 33, lines 11-13; page 34, lines 18-21; page 9, lines 19-20). Particularly note Figures 2 and 11.

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are presented below.

The rejection based on 35 U.S.C. § 112, first paragraph:

1). Whether claim 12 is unpatentable pursuant to 35 U.S.C. § 112, first paragraph, as being a single means claim.

The provisional rejections based on nonstatutory obviousness-type double patenting:

2). Whether claims 1, 8, 9, 11, 13, 14, 16, 25, and 28 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.

3). Whether claims 1, 8, 9, 11, 13, and 16 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 12 of application 09/233,249.

4). Whether claims 2-5 and 7 are provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over the corresponding claims 2-5 and 7 of application 10/980,209.

5). Whether claim 6 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 4 of application 10/980,209.

6). Whether claim 10 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 4 of application 10/980,209 in view of Wagner (US 5,742,845).

7).   Whether claims 15 and 17 are provisionally unpatentable on the ground of
nonstatutory obviousness-type double patenting over claim 1 of application
10/980,209 in view of Watanabe (US 4,542,287).

8).   Whether claim 15 is provisionally unpatentable on the ground of nonstatutory
obviousness-type double patenting over claim 12 of application 09/233,249 in
view of Watanabe (US 4,542,287).

9).   Whether claims 18 and 19 are is provisionally unpatentable on the ground of
nonstatutory obviousness-type double patenting over claims 1 and 3 of application
10/980,209 in view of Wagner (US 5,742,845).

10).   Whether claim 20 is provisionally unpatentable on the ground of nonstatutory
obviousness-type double patenting over claims 1 and 6 of application 10/980,209
in view of Wagner (US 5,742,845).

11).   Whether claim 21 is provisionally unpatentable on the ground of nonstatutory
obviousness-type double patenting over claims 1 and 4 of application 10/980,209
in view of Sime (US 5,386,104).

12).   Whether claims 22, 23, and 26 are provisionally unpatentable on the ground of
nonstatutory obviousness-type double patenting over claim 1 of application
10/980,209 in view of Wagner (US 5,742,845).

13).   Whether claims 24 and 30 are provisionally unpatentable on the ground of
nonstatutory obviousness-type double patenting over claim 1 of application
10/980,209 in view of Okamoto (US 5,064,999).

14). Whether claim 27 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Merriam Webster Collegiate Edition, 1990.

15). Whether claim 29 is provisionally unpatentable on the ground of nonstatutory obviousness-type double patenting over claims 1 and 2 of application 10/980,209 in view of Watanabe (US 4,542,287).

For further clarity, the above provisional rejections have also been outlined as below:

Claim Rejected	on	Application's	Claim	and	Secondary reference
1		10/980,209	1		none
1		09/233,249	12		none
2		10/980,209	2		none
3		10/980,209	3		none
4		10/980,209	4		none
5		10/980,209	5		none
6		10/980,209	4		none
7		10/980,209	7		none
8		10/980,209	1		none
8		09/233,249	12		none
9		10/980,209	1		none
9		09/233,249	12		none
10		10/980,209	4		Wagner (US 5,742,845)
11		10/980,209	1		none
11		09/233,249	12		none
12		none	none		none
13		10/980,209	1		none

13	09/233,249	12	none
14	10/980,209	1	none
15	10/980,209	1	Watanabe (US 4,542,287)
15	09/233,249	12	Watanabe
16	10/980,209	1	none
16	09/233,249	12	none
17	10/980,209	1	Watanabe
18	10/980,209	1 and 3	Wagner
19	10/980,209	1 and 3	Wagner
20	10/980,209	1 and 6	Wagner
21	10/980,209	1 and 4	Sime (US 5,386,104).
22	10/980,209	1	Wagner
23	10/980,209	1	Wagner
24	10/980,209	1	Okamoto (US 5,064,999)
25	10/980,209	1	none
26	10/980,209	1	Wagner
27	10/980,209	1	Merriam Webster Dictionary
28	10/980,209	1	none
29	10/980,209	1 and 2	Watanabe
30	10/980,209	1	Okamoto

ARGUMENT

The Rejection Under 35 U.S.C. § 112, First Paragraph

Claim 12 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly being a "single means claim." The Appellants respectfully disagree. Appellants' application meets the requirements of 35 U.S.C. § 112, first paragraph.

The First Paragraph of 35 U.S.C. § 112:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

Claim 12 recites:

> An Automated Teller Machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document.

Appellants respectfully submit that the Board already fully considered claim 12 in the decision rendered October 8, 2003 (in Appeal No. 2003-1651). The decision reversed the rejection of claim 12. Nowhere in the decision did the Board imply that claim 12 was a single means claim. Nowhere in the decision did the Board imply that Appellants' application did not meet the requirements of 35 U.S.C. § 112, first paragraph.

The Office's reliance on *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) is misguided. The issue in *In re Hyatt* specifically involved a claim having a means-

plus-function format. Claim 12 does not include a means-plus-function format. Claim 12 does not use "means" or "means for." Claim 12 does not invoke 35 U.S.C. § 112, sixth paragraph. Thus, claim 12 cannot be a "single means claim", as the Office alleges.

Furthermore, there is nothing wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. Applicants' functional limitation is used in association with an element to define a particular capability or purpose that is served by the recited element. The recited functional limitation serves to precisely define present structural attributes of the claimed invention. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). MPEP § 2173.05(g).

The Action's comment that "there are not [sic] distinct functions that make the device of claim 12 an ATM" is without merit. Nor is the comment a 35 U.S.C. § 112, first paragraph, issue. The Action's comment is analogous to saying that "there are no distinct functions that make an Appeal Brief an Appeal Brief." Applicants are not required to recite apparatus structure at the atomic level. The Office's own patent classification system recognizes an "ATM" (e.g., class/subclass 705/43). Claim 12 also finds support in Applicants' disclosure. It is respectfully submitted that the 35 U.S.C. § 112, first paragraph rejection is improper and should be withdrawn.

Claim 12 meets the enablement requirement of 35 U.S.C. § 112, first paragraph. The broadest scope of claim 12 reads on subject matter to which applicants' specification is enabling.

The claim is not a single means claim. The claim does not read on every conceivable structure for achieving the result. The claim does not read on "everything" that operates to conduct at least one financial transaction responsive to at least one mark-up language document. Rather, claim 12 is limited to an ATM structure, to which applicants' enabling specification contains a teaching of the manner and process of making and using the invention in terms that correspond in scope to those used in the claim. One skilled in the art would recognize an "ATM". Even the Office's own patent classification system recognizes an "ATM" (e.g., class/subclass 705/43).

Functional language does not solely define the ATM. Rather the ATM is _further_ defined by its functional capabilities. There is nothing wrong with further defining an invention in functional terms. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. _In re Swinehart_, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). _In re Venezia_, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). MPEP § 2173.05(g).

Nor does claim 12 purport to cover all ATMs. Rather the claim only covers an ATM having a structure that permits the ATM, in response to a mark-up language document, to operate to conduct a financial transaction. One skilled in the art would recognize that not all ATMs can operate in response to a mark-up language document. The invention is to an ATM that can, and this is the invention sought in claim 12. The claim does not read on all ATMs. This is further evidence that the claim is not a single means claim.

In order for claim 12 to have been a single means claim, and to have read on structure other than a mark-up language document-responsive ATM, the claim would have had to recite:

"A means that operates to conduct at least one financial transaction responsive to at least one mark-up language document." However, this is not what is recited. The rejection is improper and should be reversed.

The Office Action dated February 16, 2006 (on page 2) mentioned *In re Hyatt* and the additional cases of *Fiers v. Sugano*, 25 USPQ2d 1601, Nos. 92-1170-1171 (Fed. Cir. 1993); *Ex parte Maizel*, 27 USPQ2d 1662, No. 91-2301 (BPAI 1992); and *Ex parte Kung*, 17 USPQ2d 1545, No. 88-0962 (BPAI 1989). In response thereto, Appellants hereafter discuss in detail why these mentioned cases actually point to claim 12 as <u>not</u> being a single means claim.

In re Hyatt

Appellants respectfully submit that this case is non analogous. In this case the Court indicated that the claimed invention was defined by what followed the word "comprising." This indication limited the claim to a single "*means for* incrementally generating . . ." The Court indicated that a single means claim covers every conceivable means for achieving the stated result, while the specification discloses at most only those means known to the inventor. Thus, the claim read on subject matter to which the specification was not enabling.

Appellants respectfully submit that claim 12 is not a single means claim. Claim 12 is directed to "An Automated Teller Machine (*A TM*) that operates to conduct at least one financial transaction responsive to at least one mark-up language document." Nor does the claim equate to a single means claim. Claim 12 does not use "means" or "means for" or "for." As set forth in the specification, the ATM requires specific ATM structure, it does not constitute every conceivable means (structure). The specific structure enables a particular capability or purpose

to be served. Likewise, the functional limitation serves to precisely define present structural attributes of the ATM.

The Office confuses the basis of the decision in this case. The decision in Hyatt was based on use of language directed to unknown "*means* for incrementally generating . . ." The decision was not based on language directed to "A Fourier transform *processor* that generates incremental output signals in response to incremental input signals", as apparently interpreted by the Office. The disclosed structure of a processor differs from a non disclosed and unknown "means." Likewise, in the present situation one skilled in the art would have recognized that a disclosed ATM differs from an unknown single means.

The Court also indicted that the claim in Hyatt was drawn to a single element. Conversely, an ATM inherently implies more than one element. An ATM that operates to conduct at least one financial transaction responsive to at least one mark-up language document would also comprise more than one element. Additionally, unlike the structure in the claim in Hyatt, the ATM of claim 12 is involved in the function.

Fiers v. Sugano

Appellants respectfully submit that this case is non analogous. This case relates to award of invention priority in an interference. The recited claim at issue was directed to a product, a DNA sequence. The Court held that a specification that did not describe the structure of the recited product (but instead may have described a method of producing the product) did not satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.

From the Fiers case the Office quotes "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an

attempt to preempt the future before it has arrived." However, the quote is taken out of context. The quoted "defining what means will do so" appears to refer to defining written description in the specification, not in the claim as apparently relied upon by the Office. The Court concluded that Sugano's disclosure both met the written description requirement and was enabling.

Appellants' specification conveys with clarity to one skilled in the art, the required structure of the recited ATM in claim 12. Thus, the written description requirement of 35 U.S.C. § 112 is met. Furthermore, the enablement requirement of 35 U.S.C. § 112 is satisfied because Appellants' application contains description that enables one skilled in the art to make and use the claimed invention. It follows that the 35 U.S.C. § 112, first paragraph, rejection is improper and should be reversed.

Ex parte Maizel

Appellants respectfully submit that this case is non analogous. The 35 U.S.C. § 112, first paragraph, enablement issue noted by the Office in the Maizel case involved the specific claim language "or a biologically functional equivalent thereof." The Board held that the claim language broadened the claim to cover any structure that could achieve the stated biological function while the specification only disclosed using a specific DNA segment. For example, a "cell" could be used instead of "DNA." However, description of using of a cell did not find support in the specification. Thus, the disclosure was deemed not commensurate in scope with the broader claim. The Board indicated that the claim might be equated to a single means claim.

The language of Applicants' claim 12 does not broaden the claim to cover any ATM structure, but is limited to the structure of a mark-up language document-responsive ATM.

Claim 12 does not read on every structure that can conduct at least one financial transaction responsive to at least one mark-up language document, as the Office apparently alleges.

Ex parte Kung

Appellants respectfully submit that this case is also non analogous. The 35 U.S.C. § 112, first paragraph, enablement issue noted by the Office in the Kung case involved recited antibodies whose scope was not restricted to the specific class of antibodies formed by the process disclosed. Experiments showed that the disclosed process only provided guidance for forming a few antibodies, whereas the broad claims permitted forming more antibodies than disclosed. It was also admitted that the antibodies falling within the scope of the Kung claims could be different than those described. The Kung specification was not commensurately enabling. Thus, the Board indicated that the claim might be tantamount to a single means claim.

The disclosure was held non enabling because the Kung claim scope was not restricted to a specific class of structure (antibodies). However, in Appellants' claim 12 the scope of the recited structure is restricted to a specific class of structure (ATM) to which the process of making and using is disclosed. The reasoning stated by the Board in Kung further shows that Appellants' claim 12 is not a single means claim.

Appellants' claim 12 does not have any "means plus function" elements. Rather, the claim recites an ATM (a specific structure) that operates in a specific manner as claimed. The machine as specifically claimed in claim 12 is fully supported by the teachings in the specification.

It is respectfully submitted that the rejection of claim 12 should be reversed.

The Provisional Nonstatutory Obviousness-Type Double Patenting Rejections

The Applicable Legal Standards

An obviousness-type double patenting rejection of an application claim requires that the claim *not* be patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent (with the claim) would provide unjustified extension of the right to exclude granted by the patent. Where restriction between the claims at issue can be made, obviousness-type double patenting cannot be held. When considering the invention in a claim relied upon for rejection, the disclosure of its application may not be used as prior art. The analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). MPEP § 804 and 806.

A nonstatutory obviousness-type double patenting rejection is based on judicially created doctrine. Making an applicant aware of a potential nonstatutory obviousness-type double patenting problem can be carried out via a "provisional" rejection on the ground of nonstatutory obviousness-type double patenting (MPEP § 804(IB)). This type of rejection is "provisional" because a conflicting claim has not yet been patented to justify a legal double patenting rejection.

The conclusion of obviousness-type double patenting is made in light of the factual determination ser forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). An obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims -- a claim in the patent compared to a claim at issue in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

A teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. Assertions not based on evidence in the record lack substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Patentability determination must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Decision on the nonstatutory obviousness-type double patenting rejections is not required

The lack in the Action of any rejection based solely on prior art is taken as an admission by the Office that none can be made. The nonstatutory obviousness-type double patenting rejections are merely provisional. As a result, Appellants respectfully submit that the Board only needs to decide whether claim 12 is unpatentable.

Appellants respectfully submit that if provisional nonstatutory obviousness-type double patenting rejections are the only rejections remaining in an earlier-filed or base application, then the Office must withdraw these rejections and permit that application to issue as a patent without need of a terminal disclaimer. MPEP § 804(IB). The facts of record show that this application was either (1) filed earlier than all of the relied upon applications (i.e., 10/980,209 and 09/233,249), or (2) is the base application.

Claim 12 was not provisionally rejected on nonstatutory obviousness-type double patenting. A Board decision on claim 12 will result in either allowance or cancellation of said claim. Appellants at the present time authorize the Examiner to cancel claim 12 by Examiner's amendment if it is held unpatentable by the Board. With claim 12 no longer an issue, the

provisional nonstatutory obviousness-type double patenting rejections would then be the only rejections remaining. As a result, these rejections would have to be withdrawn because the instant application is the earlier-filed or base application.

Even if the pending provisional nonstatutory obviousness-type double patenting rejections were somehow valid (which they aren't), they should be held by the Board as moot for purposes of this appeal. Appellants respectfully request that the Board, following its decision on claim 12, order the Office to withdraw the provisional nonstatutory obviousness-type double patenting rejections and issue this application as a patent.

The source on which the rejections are based is not a valid source

The Office can only rely on the <u>claimed</u> subject matter in a relied upon application when presenting an obviousness-type double patenting rejection, not the application's entire disclosure. However, the Action provides evidence that the entire disclosure of applications was relied upon as the basis for the rejections. For example, each of the rejections states that the conflicting claims are not patentably distinct from each other because either "Application No. 10/980,209 discloses . . ." or "Application No. 09/233,249 discloses . . .". That is, each rejection relies on (and uses) the entire disclosure of an application. Nowhere is there evidence that the rejections rely on claim language alone, as is required.

The fact that some of the mentioned other application claims are not even pending, is further evidence of rejections in the present case improperly relying on an application's entire disclosure. For example, as discussed in more detail later, claims 2-7 haven't been pending in application 10/980,209 for more than 2 years. However, the subject matter in the disclosure of

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application 10/980,209 that had provided support to these (now canceled) claims 2-7 is what is relied upon in the rejections.

Thus, the source (i.e., an application's entire disclosure) on which the rejections are based is not a valid source. For this reason alone the rejections are not legally valid.

The Office has not established a *prima facie* case of obviousness

There is no evidence of record that the Office's conclusion of obviousness-type double patenting was made in light of the factual determination set forth in *Graham v. John Deere Co.*, as is required for an obviousness determination. For example, the rejection does not make clear either (A) the *differences* between the inventions defined by the conflicting claims or (B) the *reasons* why a person of ordinary skill in the art would conclude that the recited invention defined in the claim at issue in the present application would have been an obvious variation of an invention defined in a claim in another application.

The Action is silent as to the "differences" between the claims at issue in this application and the claims in other applications. That is, the Action fails to point out what is *not* taught or suggested. The Action is also silent as to reasons or conclusion for alleging obvious variation. Because the Action has not properly conducted a *Graham v. John Deere Co.* analysis, it follows that no *prima facie* case of obviousness has been presented. That is, the Action procedurally fails to establish a *prima facie* case of obviousness. Hence, the Office has not met the basic criteria for establishing a *prima facie* case of obviousness-type double patenting.

Nor has the Action established that the "differences" between the claims at issue in the present application would have been an obvious variation of claims in another application.

Where is this alleged evidence that is relied upon? Where is there any evidence of suggestion or desirability to modify a relied upon claim to produce the subject matter of a rejected claim?

Any teaching, suggestion, or motivation relied upon must be clearly and particularly identified in order to support a legally valid rejection on the basis of obviousness. The Office has not met this burden. It follows that the Action does not factually support any *prima facie* conclusion of obviousness.

If the Office does not produce a *prima facie* case of obviousness (which is the current situation), then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142).

The nonstatutory obviousness-type double patenting rejections are improper

The absence of the required explanation (MPEP § 804(IIB1)) of the "differences" between Applicants' claimed invention and other applied claims is evidence that the Action has not presented a valid nonstatutory obviousness-type double patenting rejection. A further indication that the Action does not present a valid nonstatutory obviousness-type double patenting rejection is the Action's silence regarding specific reasons why one of ordinary skill in the art would have concluded Applicants' claimed invention to be an obvious variation of the other relied upon (applied) inventions.

At best, the nonstatutory obviousness-type double patenting rejections are based on claims having some common subject matter. However, the overlapping of inventions due to claiming some common subject matter is *not* the requisite legal criteria for establishing a valid

nonstatutory obviousness-type double patenting rejection. For instance, the Office's own class/subclass classification system is based on patents claiming some common subject matter.

Also, "domination" and "double patenting" should not be confused (which may be the current situation), as they are two separate issues. An application "dominates" another when it has a broad claim which fully encompasses another's more narrow claim (MPEP § 804(II)). Domination by itself cannot support a nonstatutory obviousness-type double patenting rejection.

The Office has not established a legally valid basis for the allegations of obviousness-type double patenting. The rejections are based on mere allegations, not legally valid evidence of record. An obviousness-type double patenting rejection requires that the claimed subject matter in the relied upon different application *not* be patentably distinct from the claim being rejected. The Action lacks a showing that the instant claims are not patentably distinct from the claimed subject matter relied upon for rejection. Conversely, if it can be shown that the claims at issue are patentably distinct from each other, then the rejections are without merit. Whether claims are patentably distinct can be determined based upon whether the claims could be restricted from each other (as if present in the same application). It follows that if the claims at issue could be restricted from each other (if they were present in the same application), then the rejections are without merit.

The claims at issue are patentably distinct from each other

Appellants respectfully submit that the claims at issue are patentably distinct from each other, as discussed in more detail later. Thus, Appellants respectfully submit that the provisional nonstatutory obviousness-type double patenting rejections are improper and should be reversed.

It should be understood that Appellants' arguments below may not necessarily contain *all* of the patentably distinct features between the claims. However, the arguments do show satisfactorily evidence that proves the obviousness-type double patenting rejections presented are improper.

It should also be understood that for reasons of brevity, as previously mentioned, claim language may be referred to in Appellants' arguments in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language. For ease of understanding, the individual independent claims will be addressed first herein.

The Independent Claims

Independent Claim 1

Pending claim 1 is directed to an apparatus. Pending claim 1 recites an automated banking machine that includes a computer in operative connection with an output device, an input device, and a transaction function device. The automated banking machine further includes software executable in the computer. The software includes a browser that is operative to process HTML documents including instructions therein. The transaction function device is operative to carry out a transaction function responsive to the browser processing at least one instruction (of at least one document) that causes the computer to cause operation of the transaction function device.

<u>Claim 1 is not an obvious variation of claim 1 in application 10/980,209</u>

Claim 1 of application 10/980,209 is as set forth in the preliminary amendment filed November 2, 2004. For the benefit of the Board, a copy of said claim is provided in the Evidence Appendix.

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 1. Where does the application's claim 1 teach or suggest the recited browser of pending claim 1? Where does the application's claim 1 teach or suggest the recited transaction function device of pending claim 1? Where does the application's claim 1 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out its transaction function responsive to the browser's document processing? It doesn't. The Office has not established that pending claim 1 is an obvious variation of claim 1 in application 10/980,209.

The Office appears to be reading into the application's claim 1 more that what it specifically teaches or suggests. The Office can only rely on the claimed subject matter of claim 1 in application 10/980,209, not the application's entire disclosure (which appears to be the situation).

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 1. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 1. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 1. Therefore, Appellants respectfully submit that pending claim 1 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 1 is not legally valid and should be reversed.

Claim 1 is patentably distinct from claim 1 in application 10/980,209

In order to establish a legally valid provisional nonstatutory obviousness-type double patenting rejection, the claims at issue must be both related and not patentably distinct from each other.

The Office has not established that the inventions (of pending claim 1 and claim 1 in application 10/980,209) are related. Inventions are related if they are connected in at least one of design (e.g., structure), operation (e.g., method of use), or effect. Examples of related inventions include combination and subcombination; process and apparatus for its practice; and process and product made (MPEP § 802.01). Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 1 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

The application's claim 1 is directed to a *method*, not an *apparatus* (like pending claim 1). Even if the inventions were related (for sake of argument), they would be related as process and

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apparatus for its practice. Such inventions are *patentably distinct* if it can be shown (MPEP §
806.05(e)) that either:

> (1)   the process as claimed can be practiced by another materially different
>   apparatus or by hand; or
>
> (2)   the apparatus as claimed can be used to practice another materially
>   different process.

In such a relationship scenario, the process of application's claim 1 could be practiced by
an apparatus materially different from the apparatus of pending claim 1. For example, the
process of application's claim 1 can be used without an apparatus (like pending claim 1) that
requires a browser. That is, the process can be practiced by an apparatus without a browser. The
process of application's claim 1 is not limited to practice with the features of the apparatus of
pending claim 1. Likewise, the process of application's claim 1 can be used with an apparatus
that does not require a transaction function device that can carry out its transaction function
responsive to a browser's processing. These are patentably distinct features.

Additionally, the apparatus (of pending claim 1) as claimed can be used to practice
another materially different process from that in the application's claim 1. For example, the
pending claim 1 apparatus can be used to practice a process (unlike application's claim 1) that
does not require operating at least one computer to send at least one message from the machine.
The apparatus (of pending claim 1) is not limited to use in the process of application's claim 1.
Also, the pending claim 1 apparatus can be used to practice a process (unlike application's claim
1) that does not require operating at least one computer to send the at least one first message
responsive to at least one condition of the machine. These are also patentably distinct features.

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A legally valid obviousness-type double patenting rejection requires that the pending claim 1 and the application's claim 1 cannot be patentably distinct from each other. However, Appellants have shown otherwise. Appellants have shown that these claims, even if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 1 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 1 is not an obvious variation of claim 12 in application 09/233,249

Claim 12 of application 09/233,249 is as set forth in the original application filing on January 19, 1999. For the benefit of the Board, a copy of said claim 12 is provided in the Evidence Appendix.

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 1. Where does the application's claim 12 specifically teach or suggest the recited browser of pending claim 1? Where does the application's claim 12 teach or suggest the recited transaction function device of pending claim 1? Where does the application's claim 12 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out its transaction function responsive to the browser's document processing? It doesn't.

Pending claim 1 recites that the transaction function device is operative to carry out the transaction function *responsive to the browser processing* at least one document including at least one instruction. Dissimilarly, the application's claim 12 recites that the computer is operative to cause the transaction function device to carry out the transaction function *responsive to input* to an input device (which can receive input from machine users). That is, generally speaking, a

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transaction function device carrying out a transaction function is "responsive to the browser processing" in pending claim 1, but is differently "responsive to at least one first input to the first input device" in the application's claim 12. The Office has not established that pending claim 1 is an obvious variation of claim 12 in application 09/233,249.

The Office appears to be reading into the application's claim 12 more that what it specifically teaches or suggests. The Office can only rely on the claimed subject matter of claim 12 in application 09/233,249, not the application's entire disclosure (which appears to be the situation).

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 1. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 1. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 1. Therefore, Appellants respectfully submit that pending claim 1 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 1 is not legally valid and should be reversed.

Claim 1 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 1 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are

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even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 1 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

In the application's claim 12 the output can be generated through the output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. Where is there a requirement in pending claim 1 that output be generated through the output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document? This is a patentably distinct feature.

Furthermore, in pending claim 1 the "instruction" is linked to the transaction function device carrying out a transaction function, whereas in the application's claim 12 the "instruction" is linked to output through the output device. This is yet another patentably distinct feature.

Even if the inventions were related (for sake of argument), they would be related as subcombinations. The inventions are patentably distinct if it can be shown (MPEP § 806.05(d)) that at least one subcombination is separately useable.

In such a relationship scenario, pending claim 1 would have separate utility (from the application's claim 12), such as use in an apparatus including a computer that can, without being *responsive to input* to an input device, cause a transaction function device to carry out a transaction function. Rather, in the utility of pending claim 1 the transaction function device can

carry out the transaction function *responsive to a browser* processing at least one document (instead of responsive to input to an input device as required in the application's claim 12). That is, pending claim 1 (unlike application claim 12) does not link input device input to the transaction function device carrying out a transaction function.

Pending claim 1 has further separate utility (from the application's claim 12), such as use in an apparatus that can output a perceivable output from an output device without the output being responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document.

The application's claim 12 has separate utility (from the pending claim 1), such as use in an apparatus that can cause the transaction function device to carry out a transaction function without being responsive to a browser processing at least one document including at least one instruction.

A legally valid obviousness-type double patenting rejection requires that pending claim 1 and the application claim 12 not be patentably distinct from each other. However, Appellants have shown otherwise. Appellants have shown that these claims, even if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 1 (based on claim 12 of application 09/233,249) is not legally valid.

The Office has not established a *prima facie* case of obviousness

As previously discussed, neither claim 1 in application 10/980,209 nor claim 12 in application 09/233,249 discloses or suggests the features and relationships that are specifically recited in pending claim 1. It follows that a *prima facie* case of obviousness has not been

established. Furthermore, both claim 1 in application 10/980,209 and claim 12 in application 09/233,249 are devoid of any such teaching, suggestion, or motivation so as to produce the recited invention of pending claim 1. Therefore, Appellants respectfully submit that the rejection of claim 1 is not legally valid and should be reversed.

Appellants have shown independent claim 1 to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596, 837 F.2d 1071 (Fed. Cir. 1988). Thus, Appellants respectfully submit that the claims that depend on claim 1 are allowable on at least this same basis.

Independent Claim 8

The Action (on page 21) merely states that claim 8 is "rejected on the same rationale as independent claim 1". However, claim 8 is not identical to claim 1. Appellants are entitled to see and address the (alleged) evidence on which their patent grant is being denied. Since this evidence has not been presented, it must be concluded that it doesn't exist. It follows that the claim 8 rejection (which is based solely on this unsupported statement) is without merit.

The Action also fails to identify any source of any teaching, suggestion, or motivation in the relied upon claims to produce an obvious variation of the invention claimed by Appellants. Rather, the Action consists of mere assertions of features alleged to be the relied upon claims. The Office has failed to document its reasoning for rejection on the record which is a mandatory requirement to allow appellate review of the basis for denial of a patent. Appellants are not required to prove patentability. Rather, the burden is on the Office to establish a *prima facie* case of obviousness under the law. Otherwise, the Office is legally required to grant a patent.

When a rejection hasn't been properly explained (which is the current situation), then Appellants haven't been given fair opportunity for rebuttal thereof. Where is there any evidence of record that the Office properly conducted a *Graham v. John Deere Co.* analysis? For example, what are the "differences" between the claims? No differences have been presented, as is required to sustain the rejection. What are the reasons that one having ordinary skill in the art would find convincing for the allegation of obvious variation? No reasons have been presented. The Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the rejection cannot be legally valid. On its face the rejection (along with the clandestine reasons therefor) should be reversed.

For reasons of brevity, Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference.

Claim 8 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 8. Where does the application's claim 1 teach or suggest the recited browser of pending claim 8? Where does the application's claim 1 teach or suggest the recited transaction function device of pending claim 8? Where does the application's claim 1 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out its transaction function responsive to the browser's document processing? It doesn't. The Office has not established that pending claim 8 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 8. No

secondary teaching or suggestion has been relied upon in the rejection of pending claim 8. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 8. Therefore, Appellants respectfully submit that pending claim 8 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 8 is not legally valid and should be reversed.

Claim 8 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 8 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 8 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

The application's claim 1 is directed to a *method*, not an *apparatus* (like pending claim 8). Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) process and apparatus for its practice (MPEP § 806.05(e)).

In such a relationship scenario, the process of the application's claim 1 can be practiced by an apparatus without a browser, unlike the apparatus of pending claim 8. Also, the process of

the application's claim 1 can be used with an apparatus that does not require a transaction function device that can carry out a transaction function responsive to a document *received* by the browser. Where does the application's claim 1 receive any document? These are patentably distinct features.

The apparatus of pending claim 8 can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to *send* at least one message from the machine. Also, the pending claim 8 apparatus can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to send the at least one first message responsive to at least one condition of the machine. Where does pending claim 8 send any document? These are also patentably distinct features.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 8 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 8 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 8. Where does the application's claim 12 specifically teach or suggest the recited browser of pending claim 8? Where does the application's claim 12 teach or suggest the recited transaction function device of pending claim 8? Where does the application's claim 12 teach or suggest the recited relationship between the browser and the transaction function device, wherein the transaction function device can carry out a transaction function responsive to a

document received by the browser? It doesn't. The Office has not established that pending claim 8 is an obvious variation of claim 12 in application 09/233,249.

Pending claim 8 recites that the transaction function device is operative to carry out the transaction function responsive to a document received by the browser. Unlike pending claim 8, the application's claim 12 recites that the computer is operative to cause the transaction function device to carry out the transaction function responsive to input to the input device. That is, generally speaking, a transaction function device carrying out a transaction function is "responsive to a document received by a browser" in pending claim 8, but is differently "responsive to at least one first input to the first input device" in the application's claim 12.

In pending claim 8 the "document" is linked to the transaction function device carrying out a transaction function, whereas in the application's claim 12 the "document" is linked to output through the output device.

The Office appears to be reading into the application's claim 12 more that what it specifically teaches or suggests. Again, the Office can only rely on the claimed subject matter of claim 12, not the application's entire disclosure (which appears to be the situation).

Claim 8 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 8 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 8 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has

not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) subcombinations (MPEP § 806.05(d)). In such a relationship scenario, pending claim 8 would have separate utility (from the application's claim 12), such as in an apparatus including a computer that can, without being *responsive to input* to an input device, cause a transaction function device to carry out a transaction function. In said utility of pending claim 8 the transaction function device can carry out the transaction function *responsive to a document that is received by a browser* (instead of responsive to input to an input device as required in the application's claim 12). That is, pending claim 8 (unlike application claim 12) does not link input device input to the transaction function device carrying out a transaction function. This is a patentably distinct feature.

Pending claim 8 has further separate utility (from the application's claim 12), such as in an apparatus without an output device. Where does pending claim 8 even require an output device? This is another patentably distinct feature.

Pending claim 8 has additional separate utility (from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. There is no requirement in pending claim 8 that output be generated through an output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. This is another patentably distinct feature.

The application's claim 12 has separate utility (from the pending claim 8), such as in an apparatus that can cause the transaction function device to carry out a transaction function without being responsive to a document received by a browser. This is yet another patentably distinct feature.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 8 (based on claim 12 of application 09/233,249) is not legally valid.

Independent Claim 9

The Action (on page 21) merely states that claim 9 is "rejected on the same rationale as independent claim 1". However, claim 9 is not identical to claim 1. The Appellants are not required to prove patentability. Rather, the burden is on the Office. Appellants are entitled to see and address the (alleged) evidence on which their patent grant is being denied. Since this evidence has not been presented, it must be concluded that it doesn't exist. It follows that the claim 9 rejection (which is based solely on this unsupported statement) is without merit.

For reasons already discussed (i.e., Appellants' remarks in support of the patentability of claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the rejection cannot be legally valid. On its face the rejection should be reversed.

Appellants' remarks in support of the patentability of claims 1 an 8 are incorporated herein by reference.

<u>Claim 9 is not an obvious variation of claim 1 in application 10/980,209</u>

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 9. The application's claim 1 relates to operating at least one computer in the machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 9 steps related to operating a browser, receiving a document with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document? It doesn't. The Office has not established that pending claim 9 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 9. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 9. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 9. Therefore, Appellants respectfully submit that pending claim 9 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 9 is not legally valid and should be reversed.

<u>Claim 9 is patentably distinct from claim 1 in application 10/980,209</u>

The Office has not established that the inventions (of pending claim 9 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are

even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double-patenting rejection.

Even if the inventions (of pending claim 9 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would still be patentably distinct. In such a relationship scenario, pending claim 9 would have separate utility (from the application's claim 1), such as in a process that does not require operating at least one computer to send at least one message responsive to at least one condition of the machine. Where does pending claim 9 send any document? This is a patentably distinct feature.

Similarly, the application's claim 1 would have separate utility (from pending claim 9), such as in a process that does not require carrying out at least one transaction function with a transaction function device responsive to a document. This is another patentably distinct feature.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 9 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 9 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 9. Where does the application's claim 12 teach or suggest operating a browser, receiving a document with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document, as in pending claim 9? It doesn't. The Office has not established that pending claim 9 is an obvious variation of claim 12 in application 09/233,249.

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 9. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 9. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 9. Therefore, Appellants respectfully submit that pending claim 9 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 9 is not legally valid and should be reversed.

Claim 9 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 9 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 9 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 9 is directed to a *method*, not an *apparatus* (like application claim 12). Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) process and apparatus for its practice (MPEP § 806.05(e)).

In such a relationship scenario, the process of the pending claim 9 can be practiced by an apparatus without requiring a computer that causes a transaction function device to carry out a transaction function responsive to input to an input device. Rather, pending claim 9 can carry out a transaction function responsive to a document (instead of responsive to input to an input device as required in the application's claim 12). Pending claim 9 (unlike application claim 12) does not link input device input to a transaction function device carrying out a transaction function. This is a patentably distinct feature.

The process of pending claim 9 can also be practiced by apparatus without an output device (unlike the application's claim 12). The process of pending claim 9 can also be practiced by yet another apparatus (different from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. These are also patentably distinct features.

The application's claim 12 can be used in a process (different from that of pending claim 9), such as one causing the transaction function device to carry out a transaction function without

being responsive to a document received by a browser. This is another patentably distinct feature.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 9 (based on claim 12 of application 09/233,249) is not legally valid.

Appellants have shown independent claim 9 to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, supra. Thus, Appellants respectfully submit that the claims that depend on claim 9 are allowable on at least the same basis.

Independent Claim 11

The Action (on page 21) merely states that claim 11 is "rejected on the same rationale as independent claim 1". However, claim 11 is not identical to claim 1. The Appellants are not required to prove patentability. Rather, the burden is on the Office. Appellants are entitled to see and address the (alleged) evidence on which their patent grant is being denied. Since this evidence has not been presented, it must be concluded that it doesn't exist. It follows that the claim 11 rejection (which is based solely on the unsupported statement) is without merit.

For reasons already discussed (i.e., Appellants' remarks in support of the patentability of claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case

of obviousness. Thus, the rejection cannot be legally valid. On its face the rejection should be reversed.

Appellants' remarks in support of the patentability of claims 1 an 8 are incorporated herein by reference.

Claim 11 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 11. The application's claim 1 relates to operating at least one computer in the machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 11 steps related to operating a browser, receiving a document (including a transaction instruction embedded therein) with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document (including the transaction instruction)? It doesn't. Even more reasons why pending claim 11 is not an obvious variation of the application's claim 1 can be ascertained from Appellants' previous remarks in support of the patentability of claim 1. The Office has not established that pending claim 11 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 11. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 11. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 11. Therefore, Appellants respectfully submit that pending claim 11 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 11 is not legally valid and should be reversed.

Claim 11 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 11 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 11 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would still be patentably distinct. In such a relationship scenario, pending claim 11 would have separate utility (from the application's claim 1), such as in a process that does not require operating at least one computer to send at least one message responsive to at least one condition of the machine. Where does pending claim 11 send any document? This is a patentably distinct feature.

Similarly, the application's claim 1 would have separate utility (from pending claim 11), such as in a process that does not require operating a browser, receiving a document (including a transaction instruction embedded therein) with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document (including the

transaction instruction). These are other patentably distinct features. Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 11 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 11 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 11. Where does the application's claim 12 teach or suggest operating a browser, receiving a document (including a transaction instruction embedded therein) with the browser, and carrying out at least one transaction function with a transaction function device responsive to the document (including the transaction instruction), as in pending claim 11? It doesn't. The Office has not established that pending claim 11 is an obvious variation of claim 12 in application 09/233,249.

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 11. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 11. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 11. Therefore, Appellants respectfully submit that pending claim 11 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 11 is not legally valid and should be reversed.

Claim 11 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 11 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 11 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 11 is directed to a *method*, not an *apparatus* (like application claim 12). Even if the inventions were related (for sake of argument), they would be related as (patentably distinct) process and apparatus for its practice (MPEP § 806.05(e)).

In such a relationship scenario, the process of pending claim 11 can be practiced by an apparatus including a computer that can, without being responsive to input to an input device, cause a transaction function device to carry out a transaction function. Rather, the transaction function device can carry out the transaction function responsive to a document including a transaction instruction embedded therein (instead of responsive to input to an input device as required in the application's claim 12). Pending claim 11 (unlike application claim 12) does not

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link input device input to the transaction function device carrying out a transaction function. This is a patentably distinct feature.

The process of pending claim 11 can also be practiced by apparatus without an output device (unlike the application's claim 12). This is another patentably distinct feature.

The process of pending claim 11 can also be practiced by yet another apparatus (different from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. These are further patentably distinct features.

The application's claim 12 can be used in a process (different from that of pending claim 11), such as causing the transaction function device to carry out a transaction function without being responsive to a document received by a browser. This is another patentably distinct feature.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 11 (based on claim 12 of application 09/233,249) is not legally valid.

Independent Claim 13

The Action (on page 21) merely states that claim 13 is "rejected on the same rationale as independent claim 1". However, claim 13 is not identical to claim 1. The Appellants are not required to prove patentability. Rather, the burden is on the Office. Appellants are entitled to

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see and address the (alleged) evidence on which their patent grant is being denied. Since this evidence has not been presented, it must be concluded that it doesn't exist. It follows that the claim 13 rejection (which is based solely on the unsupported statement) is without merit.

For reasons already discussed (i.e., Appellants' remarks in support of the patentability of claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case of obviousness. Thus, the rejection cannot be legally valid. On its face the rejection should be reversed.

Appellants' remarks in support of the patentability of claims 1 an 8 are incorporated herein by reference.

Claim 13 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited in pending claim 13. The application's claim 1 is a process that relates to operating at least one computer in a machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 13 apparatus features that can cause a banking transaction to be carried out through operation of a transaction function device responsive to a document? It doesn't. The Office has not established that pending claim 13 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 13. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 13. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record.

In re Zurko, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 13. Therefore, Appellants respectfully submit that pending claim 13 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 13 is not legally valid and should be reversed.

Claim 13 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 13 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 13 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Even if the inventions were related (for sake of argument), they would still be patentably distinct. In such a relationship scenario, application's claim 1 and pending claim 13 can be related as process and apparatus for its practice. The application's claim 1 is directed to a *method*, not an *apparatus* (like pending claim 13). This is a patentably distinct feature. The process of the application's claim 1 can be practiced with an apparatus not having a computer that can cause a banking transaction to be carried out through operation of a transaction function device responsive to a document. This is another patentably distinct feature.

The apparatus of pending claim 13 can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to send at least one message from the machine. Also, the pending claim 13 apparatus can be used to practice a process (unlike the process of application claim 1) that does not require operating at least one computer to send the at least one first message responsive to at least one condition of the machine. Where does pending claim 13 send any document? These are further patentably distinct features.

Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the patentability of claim 1.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 13 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 13 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 13. In pending claim 13 a computer can cause a banking transaction to be carried out through operation of a transaction function device responsive to a document. Dissimilarly, the application's claim 12 recites that the computer is operative to cause the transaction function device to carry out a transaction function responsive to input to the input device. That is, generally speaking, a transaction function device carrying out a banking transaction is "responsive to a document" in pending claim 13, but is differently "responsive to at least one first input to the first input device" in the application's claim 12. Where does the

application's claim 12 teach or suggest the ability to carry out a banking transaction through operation of a transaction function device responsive to a document? It doesn't. The Office has not established that pending claim 13 is an obvious variation of claim 12 in application 09/233,249.

The Office appears to be reading into the application's claim 12 more that what it specifically teaches or suggests. Again, the Office can only rely on the claimed subject matter of claim 12, not the application's entire disclosure (which appears to be the situation).

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 13. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 13. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 13. Therefore, Appellants respectfully submit that pending claim 13 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 13 is not legally valid and should be reversed.

Claim 13 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 13 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 13 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 13 has separate utility (from the application's claim 12), because it can be used without linking input device input to a transaction function device carrying out a transaction. This is a patentably distinct feature.

Likewise, the application's claim 12 has separate utility (from pending claim 13), because it can be used without linking a document to a transaction function device carrying out a transaction. This is a patentably distinct feature.

In pending claim 13 the "document" is linked to a transaction function device carrying out a banking transaction, whereas in the application's claim 12 the "document" is linked to output through an output device. Where does pending claim 13 even require an output device? This is another patentably distinct feature.

Furthermore, in the application's claim 12 the output can be generated through the output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. There is no requirement in pending claim 13 that output be generated through an output device responsive to input device input, transaction machine interface software, and at least one command instruction in an instruction document. This is yet another patentably distinct feature.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double

patenting rejection of pending claim 13 (based on claim 12 of application 09/233,249) is not

legally valid.

Appellants have shown independent claim 13 to be allowable. "If an independent claim

is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious"

(MPEP 2143.03). *In re Fine*, supra. Thus, Appellants respectfully submit that the claims that

depend on claim 13 are allowable on at least the same basis.

Independent Claim 16

The Action (on page 21) merely states that claim 16 is "rejected on the same rationale as

independent claim 1". However, claim 16 is not identical to claim 1. The Appellants are not

required to prove patentability. Rather, the burden is on the Office. Appellants are entitled to

see and address the (alleged) evidence on which their patent grant is being denied. Since this

evidence has not been presented, it must be concluded that it doesn't exist. It follows that the

claim 16 rejection (which is based solely on the unsupported statement) is without merit.

For reasons already discussed (i.e., Appellants' remarks in support of the patentability of

claim 8), the Office has not even met the most basic of criteria for establishing a *prima facie* case

of obviousness. Thus, the rejection cannot be legally valid. On its face the rejection should be

reversed.

Appellants' remarks in support of the patentability of claims 1 an 8 are incorporated

herein by reference.

Claim 16 is not an obvious variation of claim 1 in application 10/980,209

The application's claim 1 does not teach or suggest the features and relationships recited

in pending claim 16. The application's claim 1 is a process that relates to operating at least one

computer in a machine to send at least one message from the machine, responsive to at least one condition of the machine. Where does the application's claim 1 teach or suggest the pending claim 16 steps related to processing a document with a computer, and carrying out at least a portion of a banking transaction with a transaction function device responsive to processing the document with the computer? It doesn't. The Office has not established that pending claim 16 is an obvious variation of claim 1 in application 10/980,209.

Appellants have shown that claim 1 in application 10/980,209 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 16. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 16. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 1 in application 10/980,209 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 16. Therefore, Appellants respectfully submit that pending claim 16 cannot be an obvious variation of claim 1 in application 10/980,209. Thus, the rejection of claim 16 is not legally valid and should be reversed.

Claim 16 is patentably distinct from claim 1 in application 10/980,209

The Office has not established that the inventions (of pending claim 16 and claim 1 in application 10/980,209) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 16 and claim 1 in application 10/980,209) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

In such a relationship scenario, pending claim 16 would have separate utility (from the application's claim 1), such as in a process that does not require operating at least one computer to send at least one message responsive to at least one condition of the machine. Where does pending claim 16 send any document? This is a patentably distinct feature.

Similarly, the application's claim 1 would have separate utility (from pending claim 16), such as in a process that does not require processing a document with a computer, and carrying out at least a portion of a banking transaction with a transaction function device responsive to processing the document with the computer. These are other patentably distinct features.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Thus, the provisional nonstatutory obviousness-type double patenting rejection of pending claim 16 (based on claim 1 of application 10/980,209) is not legally valid.

Claim 16 is not an obvious variation of claim 12 in application 09/233,249

The application's claim 12 does not teach or suggest the features and relationships recited in pending claim 16. Where does the application's claim 12 teach or suggest steps related to processing a document with a computer, and carrying out at least a portion of a banking transaction with a transaction function device responsive to processing the document with the

computer, as in pending claim 16? It doesn't. The Office has not established that pending claim 16 is an obvious variation of claim 12 in application 09/233,249.

Appellants have shown that claim 12 in application 09/233,249 alone does not teach or suggest all of the features and relationships that are specifically recited in pending claim 16. No secondary teaching or suggestion has been relied upon in the rejection of pending claim 16. Thus, the rejection is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established.

Claim 12 in application 09/233,249 is devoid of any teaching, suggestion, or motivation to produce the recited invention of pending claim 16. Therefore, Appellants respectfully submit that pending claim 16 cannot be an obvious variation of claim 12 in application 09/233,249. Thus, the rejection of claim 16 is not legally valid and should be reversed.

Claim 16 is patentably distinct from claim 12 in application 09/233,249

The Office has not established that the inventions (of pending claim 16 and claim 12 in application 09/233,249) are related. Where has the Office established that the inventions are even related? It hasn't. Thus, the Office has not established a basis for the nonstatutory obviousness-type double patenting rejection.

Even if the inventions (of pending claim 16 and claim 12 in application 09/233,249) were somehow shown to be related by the Office (which hasn't been established), the Office still has not shown that the inventions are not patentably distinct from each other. Conversely, the inventions, if somehow shown to be related, would still be patentably distinct from each other.

Pending claim 16 is directed to a *method,* not an *apparatus* (like application claim 12). This is a patentably distinct feature.

The process of pending claim 16 can be practiced by an apparatus including a computer that can, without being responsive to input to an input device, carry out at least a portion of a banking transaction. The process of pending claim 16 can carry out the portion of a banking transaction responsive to processing a document (instead of responsive to input to an input device as required in the application's claim 12). That is, pending claim 16 (unlike application claim 12) does not link input device input to carrying out the portion of a banking transaction. This is another patentably distinct feature.

The process of pending claim 16 can also be practiced with an apparatus without an output device (unlike the application's claim 12). The process of pending claim 16 can also be practiced by yet another apparatus (different from the application's claim 12), such as in an apparatus with an output device that can provide its output unrelated to input device input, transaction machine interface software, and a command instruction in an instruction document. These are further patentably distinct features.

The application's claim 12 can be used in a process (different from that of pending claim 16), such as causing the transaction function device to carry out a transaction function without being responsive to processing a document with a computer. This is yet another patentably distinct feature.

Appellants have shown that the claims, if somehow shown to be related, would still be patentably distinct from each other. Even more reasons why the claims are patentably distinct from each other can be ascertained from Appellants' previous remarks in support of the

patentability of pending claim 1. The provisional nonstatutory obviousness-type double patenting rejection of pending claim 16 (based on claim 12 of application 09/233,249) is not legally valid.

Appellants have shown independent claim 16 to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, supra. Thus, Appellants respectfully submit that the claims that depend on claim 16 are allowable on at least the same basis.

The Dependent Claims

Claims 2-7, 10, 18-21, and 29

Pending claims 2-7, 10, 18-21, and 29 were provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over at least one of claims 2-7 of application 10/980,209.

Claims 2-7 were canceled in application 10/980,209 at its initial filing on November 2, 2004. That is, the claims in application 10/980,209 that the Office newly relies upon for rejection have not been pending for more than 2 years. Any rejection that relies on one of these claims 2-7 canceled in application 10/980,209 is without merit. Thus, the rejection of pending claims 2-7, 10, 18-21, and 29 should be reversed. These claims no longer need to be discussed herein.

Claim 14

Pending claim 14 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.

Pending claim 14 depends from claim 13. Appellants have already shown that pending claim 13 is not an obvious variation of claim 1 of application 10/980,209.

Furthermore, where does claim 1 of application 10/980,209 teach or suggest a computer that includes document handling software, where the computer is operative to carry out a banking transaction responsive to the document handling software processing a document? The Office has not established a *prima facie* case of obviousness.

Claim 15

Pending claim 15 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over *either* claim 1 of application 10/980,209 in view of Watanabe *or* claim 12 of application 09/233,249 in view of Watanabe.

Pending claim 15 depends from claim 13. Appellants have already shown that pending claim 13 is not an obvious variation of *either* claim 1 of application 10/980,209 *or* claim 12 of application 09/233,249.

Watanabe cannot alleviate the previously discussed deficiencies of *either* claim 1 of application 10/980,209 *or* claim 12 of application 09/233,249, because Watanabe also does not teach or suggest Appellants' recited features which are not found therein. Nor has Watanabe been relied upon for such purpose. Nor does Watanabe teach or suggest the additionally recited features in claim 15. Watanabe is only relied upon for a "note dispenser". The Office has not established a *prima facie* case of obviousness.

Claim 17

Pending claim 17 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Watanabe.

Pending claim 17 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209.

Watanabe cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209, because Watanabe also does not teach or suggest Appellants' recited features which are not found therein. Nor has Watanabe been relied upon for such purpose. Nor does Watanabe teach or suggest the additionally recited features in claim 17. Watanabe is only relied upon for a "note dispenser". The Office has not established a *prima facie* case of obviousness.

Claim 22

Pending claim 22 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner.

Pending claim 22 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209.

Wagner cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209, because Wagner also does not teach or suggest Appellants' recited features which are not found therein. Nor has Wagner been relied upon for such purpose.

Nor does Wagner teach or suggest the additionally recited features in claim 22. The Action is silent as to where Wagner allegedly teaches or suggests the recited features. Nor does

Wagner teach or suggest providing output in the manner recited. For reasons discussed herein, Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness.

Wagner is non-enabling

Wagner's disclosure does not meet the requirements of 35 U.S.C. § 112. Thus, Wagner (U.S. Patent No. 5,742,845) is non-enabling.

Wagner's use of the term "non-standard I/O device" is vague and indefinite, and renders the disclosure non-enabling. Wagner provides examples of non-standard I/O devices, such as smart card reader (32), PIN pad (34), magnetic card swipe reader (36), and printer (38). To anyone having skill in the computer arts "I/O" means "input/output." However, none of these devices is an *input/output* device. A smart card reader, PIN pad, and magnetic card swipe reader are input-only devices. A printer is an output-only device. Thus, Wagner's use of "I/O device" is not in compliance with known accepted standards. Nor did Wagner specifically redefine the accepted meaning of an "I/O device." It follows that one having ordinary skill in the art would not be able to ascertain the scope of Wagner's disclosed invention. Wagner's disclosure is non-enabling.

Again, the term "*non-standard* I/O device" is vague and indefinite, and not specifically defined to a sufficient degree to overcome the lack of any accepted meaning. Nor is the term one that has an accepted meaning that is well known in the art. The scope of the term appears to improperly cover every conceivable structure that is not a "standard I/O device." Such examples include paper and a pencil. The undue breath of the term renders the disclosure non enabling. One having ordinary skill in the art would be unable to carry out Wagner's disclosed invention, even with undue experimentation. The Wagner patent does not teach sufficient information to

put the public in possession of the invention and to enable those skilled in the art to make and use the invention. There is nothing in the patent that informs the public how to use the invention and how to avoid infringement. In conclusion, the disclosure of Wagner is non-enabling. The applied Wagner reference does not constitute prior art to Appellant's invention.

Claim 23

Pending claim 23 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner.

Pending claim 23 depends from claim 22/16. Appellants have already shown that pending claims 16 and 22 are not an obvious variation of claim 1 of application 10/980,209 in view of Wagner.

Nor does Wagner teach or suggest the additionally recited features in claim 23. The Action is silent as to where Wagner allegedly teaches or suggests the recited features. Nor does Wagner teach or suggest providing output in the manner recited. For reasons previously discussed, Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness.

Claim 24

Pending claim 24 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Okamoto.

Pending claim 24 depends from claim 23/22/16. The Office already admitted that claim 1 of application 10/980,209 did not teach or suggest all of the pending claim 23 features. As a

result, the Office relied on Wagner in the rejection of claim 23. However, the rejection of claim 24 (which depends on claim 23) is absent Wagner. Therefore, based on the Office's own admission of deficiency, the rejection of claim 24 is without merit.

Nor does Okamoto teach or suggest the additionally recited features in claim 24. The Action is silent as to where Okamoto allegedly teaches or suggests the recited features. Nor does Okamoto teach or suggest providing visual output through a screen in the manner recited. The Office has not established a *prima facie* case of obviousness.

Claim 25

Pending claim 25 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.

Pending claim 25 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209.

Furthermore, where does claim 1 of application 10/980,209 teach or suggest that an HTML document is processed by a computer? The Office has not established a *prima facie* case of obviousness.

Claim 26

Pending claim 26 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Wagner.

Pending claim 26 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209.

Wagner cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209, because Wagner also does not teach or suggest Appellants' recited features which are not found therein. Nor has Wagner been relied upon for such purpose.

Nor does Wagner teach or suggest the additionally recited features in claim 26. The Action is silent as to where Wagner allegedly teaches or suggests the recited features. Nor does Wagner teach or suggest processing a document to cause action in the manner recited. For reasons previously discussed, Wagner is also non-enabling. The Office has not established a *prima facie* case of obviousness.

Claim 27

Pending claim 27 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Merriam Webster Dictionary ("Merriam").

Pending claim 27 depends from claim 16. Appellants have already shown that pending claim 16 is not an obvious variation of claim 1 of application 10/980,209.

Merriam cannot alleviate the previously discussed deficiencies of claim 1 of application 10/980,209, because Merriam also does not teach or suggest Appellants' recited features which are not found therein. Nor has Merriam been relied upon for such purpose.

The Action admits that claim 1 of application 10/980,209 does not teach or suggest the additionally recited features of claim 27. Nor does Merriam teach or suggest the features in claim 27. The Action is silent as to where Merriam allegedly teaches or suggests the recited features. Nor does Merriam teach or suggest a computer that is operative to cause carrying out of a portion of a banking transaction responsive to at least one software applet. Thus, the rejection

is improperly based on mere assertions and not concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. The Office has not established a *prima facie* case of obviousness.

Claim 28

Pending claim 28 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209.

Pending claim 28 depends from claim 14/13. Appellants have already shown that pending claims 13 and 14 are not an obvious variation of claim 1 of application 10/980,209.

Furthermore, where does claim 1 of application 10/980,209 teach or suggest a computer that is adapted to automatically operate a transaction function device responsive to a processing of a document with document handling software? The Office has not established a *prima facie* case of obviousness.

Claim 30

Pending claim 30 was provisionally rejected as unpatentable on the ground of nonstatutory obviousness-type double patenting over claim 1 of application 10/980,209 in view of Okamoto.

Pending claim 30 depends from claim 13. Appellants have already shown that pending claim 13 is not an obvious variation of claim 1 of application 10/980,209.

Nor does Okamoto teach or suggest the additionally recited features in claim 30. The Action is silent as to where Okamoto allegedly teaches or suggests the recited features. Nor does Okamoto teach or suggest a computer that is operative to automatically display a visual output through a display device responsive to processing a document with the computer. The Office has not established a *prima facie* case of obviousness.

CONCLUSION

Each of Appellants' claims meets the requirements of 35 U.S.C. § 112. The provisional

rejections on the grounds of nonstatutory obviousness-type double patenting are without merit.

Each of the pending claims specifically recites features, relationships, and/or steps that are

neither disclosed nor suggested as alleged by the Office. Furthermore, the applied application

claims, taken either alone or in combination with applied art, are devoid of any teaching,

suggestion, or motivation for combining features of thereof so as to produce the recited

invention. For these reasons it is respectfully submitted that all of the pending claims are

allowable.

Respectfully submitted,

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CLAIMS APPENDIX

1.   Apparatus comprising:

an automated banking machine, including:

an output device, wherein the output device outputs information, whereby a user is enabled to perceive outputs from the output device;

an input device, wherein the input device is operative to receive inputs, whereby a user is enabled to provide inputs to the machine;

a transaction function device, wherein the transaction function device is selectively operative to carry out a transaction function;

a computer, wherein the computer is in operative connection with the output device, the input device and the transaction function device;

software executable in the computer, wherein the software includes a

browser, wherein the browser is operative to process HTML documents

including instructions therein, and wherein the transaction function device

is operative to carry out the transaction function responsive to the browser

processing at least one document including at least one instruction adapted

to cause the computer to cause operation of the transaction function

device.

2.   The apparatus according to claim 1 wherein the transaction function device includes a

sheet dispenser.

3.   The apparatus according to claim 1 wherein the transaction function device includes a

card reader.

4.   The apparatus according to claim 1 wherein the transaction function device includes a

printer.

5.   The apparatus according to claim 1 wherein the transaction function device includes a

depository.

6. The apparatus according to claim 1 wherein the transaction function device includes a keyboard.

7. The apparatus according to claim 1 wherein the software is operative responsive to an instruction to access at least one HTTP record address, wherein the at least one HTTP record address corresponds to at least one HTTP record including instructions adapted to cause the computer to cause operation of the transaction function device.

8. An Automated Teller Machine (ATM) comprising:

    a computer;

    a browser operating in the computer;

    a transaction function device in operative connection with the computer, wherein the computer is operative to cause the transaction function device to carry out a transaction function responsive to at least one HTML format document that is received by the browser.

9.   A method comprising the steps of:

a)   operating a browser in at least one computer in connection with an automated banking machine;

b)   receiving at least one HTML format document with the browser, wherein the at least one HTML format document includes at least one transaction instruction;

c)   carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one HTML format document.

10.   The method according to claim 9 wherein the automated banking machine includes an output device in operative connection with the computer, and further comprising the step of:

d)   producing an output through the output device responsive to the at least one HTML format document.

11.   A method comprising the steps of:

a)   operating a browser in at least one computer in operative connection with an automated banking machine;

b)   receiving at least one document with the browser, wherein the document includes at least one transaction instruction embedded therein;

c)   carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one document including the at least one transaction instruction.

12.   An Automated Teller Machine (ATM) that operates to conduct at least one financial transaction responsive to at least one mark-up language document.

13.   An automated banking machine comprising:

a computer in operative connection with the banking machine;

at least one transaction function device in the banking machine adapted to carry out at least a portion of a banking transaction;

wherein the computer is adapted to cause at least one banking transaction to be carried out through operation of the at least one transaction function device responsive to at least one mark up language document.

14. The machine according to claim 13 wherein the computer includes document handling software, and wherein the computer is operative to carry out the at least one banking transaction responsive to the document handling software processing the at least one mark up language document.

15. The automated banking machine according to claim 13 wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one note from the note dispenser.

16. A method comprising the steps of:

    a) providing an automated banking machine including at least one transaction function device, wherein the automated banking machine is in operative connection with at least one computer;

    b) processing at least one mark up language document with the computer;

c)	carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer in step (b).

17.	The method according to claim 16 wherein the transaction function device includes a note dispenser, and wherein in step (c) the portion of the banking transaction includes dispensing at least one note with the note dispenser.

18.	The method according to claim 16 wherein the transaction function device includes at least one reader device, and wherein in step (c) the portion of the transaction includes reading indicia with the reading device.

19.	The method according to claim 18 wherein the reading device includes a card reader, and wherein in step (c) indicia is read from a card.

20.	The method according to claim 16 wherein the transaction function device includes at least one key, and wherein in step (c) the portion of the banking transaction includes sensing an input through the at least one key.

21.	The method according to claim 16 wherein the transaction function device includes a depository, and wherein in step (c) the portion of the banking transaction includes receiving a deposit with the depository.

22. The method according to claim 16 wherein in step (a) the banking machine includes at least one output device, and further comprising the step of:

        d)   providing at least one output through the output device responsive to processing at least one mark up language document with the computer.

23. The method according to claim 22 wherein the computer includes browser software, and wherein in step (d) the at least one output is provided responsive to the browser software processing the at least one mark up language document.

24. The method according to claim 23 wherein the output device includes a screen and wherein in step (d) the at least one output includes a visual output through the screen.

25. The method according to claim 16 wherein in step (b) at least one HTML document is processed by the computer.

26. The method according to claim 16 wherein the automated banking machine includes an output device, and wherein in step (c) processing the at least one mark up language document is operative to cause the computer to provide an output through the output device and to carry out at least the portion of the banking transaction.

27. The method according to claim 16 wherein the computer is operative to cause the carrying out of the portion of the banking transaction responsive to at least one software applet.

28. The apparatus according to claim 14 wherein the document handling software includes a browser, wherein the computer is adapted to automatically operate at least one transaction function device responsive to the processing of at least one mark up language document with the document handling software.

29. The apparatus according to claim 28 wherein at least one transaction function device includes a currency sheet dispenser, and wherein the banking transaction includes dispensing at least one currency sheet from the currency sheet dispenser.

30. The apparatus according to claim 13 and further including a display device having a display screen, wherein the computer includes document handling software, wherein the computer is operative to automatically display at least one visual output through the display device responsive to processing at least one mark up language document with the computer.

(ix) **EVIDENCE APPENDIX**

Claim 1 in application 10/980,209

A method comprising:

a) operating at least one computer in an automated banking machine, wherein the automated banking machine is operative to carry out financial transactions responsive to operating the at least one computer and includes at least one input device adapted to receive identifying inputs usable to identify at least one of users and user financial accounts, and a cash dispenser adapted to dispense cash to users of the machine;

b) responsive to at least one first condition of the machine that occurs responsive to operation of the machine, operating the at least one computer in the machine to send at least one first message from the machine to at least one first computer remote from the machine, wherein the at least one first message comprises at least one markup language document, wherein the at least one markup language document includes data corresponding to the at least one first condition.

<u>Claim 12 in application 09/233,249</u>

A first automated transaction machine apparatus including:

a first computer of a first type, wherein the first computer includes at least one first output device, wherein the first output device is operative to provide at least one output to users of the first machine, and at least one first input device, wherein the first input device is operative to receive at least one input from users of the machine;

a first transaction function device in operative connection with the first computer, wherein the first transaction function device is operative to carry out a transaction function;

first transaction machine interface software in operative connection with the first computer;

a first instruction document in operative connection with the first computer, wherein the first instruction document includes at least one command instruction;

wherein the first computer is operative responsive to at least one first input to the first input device to cause the first transaction function device to carry out the transaction function, and wherein the first computer is further operative to generate a first output through the first output device responsive to the first input, the first transaction machine interface software and at least one command instruction in the first instruction document.

(x)   **RELATED PROCEEDINGS APPENDIX**

Attached is a copy of the Board Decision (dated October 8, 2003) regarding Appeal No.

2003-1651, as identified in section (ii) of this Brief.
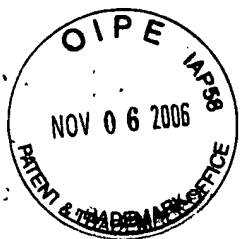
Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

OCT 0 8 2003

**U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

<u>Ex parte</u> JAY PAUL DRUMMOND et al.

Appeal No. 2003-1651
Application No. 09/193,787[1]

ON BRIEF

Before ABRAMS, McQUADE, and NASE, <u>Administrative Patent Judges</u>.

NASE, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on appeal from the examiner's rejection (Paper No. 18, mailed

September 16, 2002) of claims 1 to 30, which are all of the claims pending in this

application. On page 2 of the reply brief (Paper No. 22, filed April 18, 2003), the

appellants noted that (1) they are willing to amend dependent claim 27 to include

mutually agreeable language in order to overcome the sole rejection of claim 27 as

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[1] Filed November 17, 1998. According to the appellants, the application claims benefit of
provisional Application No. 60/031,956, filed November 27, 1996.

being indefinite under the second paragraph of 35 U.S.C. § 112; and (2) the rejection of

claim 27 no longer appears to be an issue. Accordingly, we deem the appeal with

respect to claim 27 to be withdrawn and we dismiss the appeal with respect to claim 27.

Claims 1 to 26 and 28 to 30 remain on appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to automated banking machines (specification,

p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants'

brief.

The references of record relied upon by the examiner in rejecting the appealed

claims are:

McLean	4,337,864	July 6, 1982
McMillan	5,436,435	July 25, 1995
Russell et al. (Russell)	5,905,248	May 18, 1999
Zeanah et al. (Zeanah)	5,933,816[2]	Aug. 3, 1999

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[2] This patent issued from Application No. 08/908,413, filed August 7, 1997. This patent claims
benefit of provisional Application No. 60/029,209, filed October 31, 1996.

Claims 1 to 6, 8-13, 16 and 22 to 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Zeanah.

Claims 7, 14, 28 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of Russell and McLean.

Claims 15 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McLean.

Claims 18 to 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zeanah in view of McMillan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed March 11, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 20, filed January 17, 2003) and

reply brief (Paper No. 22, filed April 18, 2003) for the appellants' arguments

thereagainst.

OPINION

The appellants assert (brief, pp. 11-24) that (1) Zeanah is not available as prior

art under 35 U.S.C. § 102(e); and (2) the 37 CFR § 1.131 declaration of Jay Paul

Drummond (Paper No. 13, filed February 4, 2002) is sufficient to overcome the prior art

rejections under appeal. We agree.

The burden of establishing a prima facie case of anticipation resides with the

examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.

1984). Likewise, the examiner bears the initial burden of presenting a prima facie case

of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed.

Cir. 1993).

It is the examiner's burden to establish that Zeanah is available as prior art under

35 U.S.C. § 102(e)[3] with respect to the claims under appeal. This the examiner has not

done.

_____

[3] 35 U.S.C. § 102(e) provides that a person shall be entitled to a patent unless the invention was
described in a patent granted on an application for patent by another filed in the United States before the
invention by the applicant for patent.

To establish that Zeanah is available as prior art under 35 U.S.C. § 102(e) with

respect to the claims under appeal, the examiner must determine that the effective filing

date of Zeanah is prior to the effective filing date of the claimed subject matter. Thus,

the examiner must determine the effective filing date of Zeanah and the effective filing

date of the claimed subject matter.

Zeanah is clearly entitled to at least an effective filing date of August 7, 1997.

Zeanah is not entitled to an effective filing date of October 31, 1996 unless the

provisional application (Application No. 60/029,209) discloses the claimed invention in

the manner required by the first paragraph of 35 U.S.C. § 112.[4] The examiner has not

determined that provisional Application No. 60/029,209 discloses the claimed invention

in the manner required by the first paragraph of 35 U.S.C. § 112. Accordingly, for

purposes of this appeal, the examiner has only determined that Zeanah is entitled to an

effective filing date of August 7, 1997.[5]

The appellants claim benefit back to provisional Application No. 60/031,956,

filed November 27, 1996. To apply Zeanah as prior art under 35 U.S.C. § 102(e), the

---

[4] See 35 U.S.C. § 119(e).

[5] The examiner's position (answer, pp. 14-15) that due to the presumption of validity the patent to Zeanah is presumed to be entitled to the October 31, 1996 filing date of the provisional application is without merit.

examiner must also determine the effective filing date of the claimed subject matter

(e.g., is the claimed subject matter entitled to an effective filing date of November 27,

1996). The examiner has not set forth the effective filing date of the claimed subject

matter.[6]

Since the examiner has not established that the effective filing date of Zeanah is

prior to the effective filing date of the claimed subject matter, the examiner has not

established that Zeanah is available as prior art under 35 U.S.C. § 102(e).

In any event, even if Zeanah was available as prior art under 35 U.S.C. § 102(e)

with an effective filing date of October 31, 1996, the appellants submit that the

Drummond declaration establishes reduction to practice of the subject matter of claims

1-4, 6-19 and 22-27 prior to July 7, 1996, thus overcoming the prior art rejections of

claims 1-4, 6-19 and 22-27. The appellants admit (brief, p. 15) that the differences

between claims 5, 20, 21 and 28 to 30 and claims 1-4, 6-19 and 22-27 would have

been obvious to one of ordinary skill in the art. Thus, the appellants argue that the prior

art rejections of claims 5, 20, 21 and 28 to 30 is also overcomed by the Drummond

declaration.

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[6] The appellants assert that the effective filing date of the claimed subject matter is November 27,
1996.

The examiner's sole expressed objection to accepting the Drummond declaration

(answer, pp. 17-18) is that it is not signed by all the joint inventors of the claims under

rejection (i.e., claims 1 to 26 and 28 to 30). However, this objection is not a proper

basis for refusing to accept the Drummond declaration since that declaration is signed

by the inventor of the subject matter of claims 1 to 4, 6 to 19 and 22 to 27). 37 CFR

§ 1.131 permits such a declaration to be signed by less that all of the inventors.

Since the examiner has not proffered any valid objection as to why the

Drummond declaration does not establish a reduction to practice of the subject matter

of claims 1-4, 6-19 and 22-27 prior to July 7, 1996, the Drummond declaration must be

accepted by us as sufficient to overcome the prior art rejections under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 1

to 6, 8-13, 16 and 22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the

examiner to reject claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is

reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 8-13, 16 and

22 to 26 under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject

claims 7, 14, 15, 17 to 21 and 28 to 30 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS   )
Administrative Patent Judge   )
)
)
)
) BOARD OF PATENT
JOHN P. McQUADE   )   APPEALS
Administrative Patent Judge   )   AND
) INTERFERENCES
)
)
)
JEFFREY V. NASE   )
Administrative Patent Judge   )

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